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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/496,491	02/02/2000	Detlef Groth	BEIERSDORF-606-WCG	6328

7590

08/26/2003

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EXAMINER

VARGOT, MATHIEU D

ART UNIT

PAPER NUMBER

1732

DATE MAILED: 08/26/2003

22

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/496,491

Applicant(s)

GROTH et al.

Examiner

M. VARGOT

Group Art Unit

1732

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

☒ Responsive to communication(s) filed on 9/6/03

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

☒ Claim(s) 1-3, 6, 7, 9 + 10 is/are pending in the application.

Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-3, 6, 7, 9 + 10 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement

## Application Papers

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

☐ All ☐ Some\* ☐ None of the:

☐ Certified copies of the priority documents have been received.

☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_

☐ Copies of the certified copies of the priority documents have been received  
in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Reference(s) Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other \_\_\_\_\_

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1. Claims 1-3, 6, 7, 9 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

While applicant has limited claim 1 to "consisting of" terminology, it is submitted that such renders claim 1 and claim 7 now indefinite, in that the above-noted terminology is intended to preclude any steps not explicitly set forth. Claim 1 already has optional steps (see lines 10-11) and the instant closed language renders it indefinite as to whether these steps are being performed. It would appear that closed language claims need to be limited to an exact sequence of steps, for indeed many steps can be considered to be optional, to be performed only if desired. Also, since the independent claim 1 is closed, claim 7 is indefinite in adding an additional step, which is not permitted. Claims dependent on a claim using "consisting of" language can not recite additional process steps. Claim 9 is indefinite in that it is unclear whether the two or more layers are each subjected to imparted holographic structures before the electron beam curing or not. Also, in both claims 1 and 9, it should be clearly recited that the embossed support foil transfers (embosses) the layer(s) in claims 1 and 9 "so that corresponding holographic structures are imparted to the sheet". Finally, claim 6 is indefinite in depending on cancelled claim 5 and "the coating film" at line 1 therein lacks antecedent basis.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

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such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 6, 7, 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over

McGrew essentially for reasons of record noting the following. While the instant claims (ie, 1-3, 6, 7 and 10) have been limited to "consisting of" language, which limits the process to only the recited steps, it is submitted that the claims are nevertheless obvious over the applied reference which discloses all the instant steps and some additional ones. As noted by applicant, the additional steps are --1) a preferred step of using a smooth polyester film, which film can be separated or stay with the cured sheet; and 2) coating the relief surface of the cured resin with a substance to increase its reflectivity (ie, metal). Eliminating the first step would have been very easy for one of ordinary skill in the art, since such is disclosed as being **preferable** -- indeed, it has long been settled that a reference is not limited to preferred embodiments and that such would have been readily dispatched with if not needed. Concerning the latter, the metal coating is disclosed as increasing the reflectivity/brightness (col. 3, line 25; col. 4, lines 59-61) of the relief surface. However, it is submitted that one of ordinary skill in the art, not requiring this increased brightness, would have found eliminating the metal coating as obvious. Clearly, while these additional steps may be preferred, or in fact usually performed, to enhance the final product, one of ordinary skill in this art would have had no problem making a usable article without these additional steps.

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Concerning instant claim 9, see column 4, lines 64-65, which teach that additional coatings are provided over the relief surface and these are cured by electron beam. In view of this disclosure, the indication of allowability for claim 9 has been withdrawn.

3. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

In view of the amendment, the 102 rejection over McGrew has been replaced with a 103. The amendment (bottom of page 2) states that applicant has "surprisingly" found that the process can be "greatly simplified" by avoiding the "unnecessary extra steps" of McGrew. Indeed, there really is nothing surprising about this. The elimination of preferred or customary steps is nothing but conventional, and certainly obvious, should these steps not be needed to make the product. It is respectfully submitted that this is exactly what the instant claims and arguments constitute, not a surprising result.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Vargot whose telephone number is 703 308-2621.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-0661.

M. Vargot

August 25, 2003

*M. Vargot*  
MATHIEU D. VARGOT  
PRIMARY EXAMINER  
GROUP 1300

*8/25/03*